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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,647	08/14/2001	Hiroko Sugimoto	NAK1-BP74	9533

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EXAMINER

SHELEHEDA, JAMES R

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 03/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,647

Applicant(s)

SUGIMOTO ET AL.

Examiner

James Sheleheda

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) 1-6, 15-16 and 18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-14, 17 and 19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's election with traverse of Group III (claims 7-14, 17 and 19) in Paper No. 6 (filed 2/17/2004) is acknowledged. However, applicant did not provide any specifics of the traversal.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6, 15, 16 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups I, II and IV, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6 (filed 2/17/2004).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 17 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grossman et al. (Grossman) (5,907,321).

As to claim 7, Grossman discloses a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67 and column 6, lines 1-7), comprising:

content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45);

receiving means (tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

first reproducing means for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18);

instruction receiving means (remote control receiver, 48) for receiving a user instruction (column 6, lines 11-15);

instruction judging means (microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18); and

second reproducing means for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) when the received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

As to claim 8, Grossman discloses the second reproducing means including display-mode controlling means (graphics generator, 68) for controlling a reproduction display-mode of the commercial content (column 7, lines 29-42) in accordance with a content of the user instruction (wherein the content is displayed upon receipt of the

channel change command; column 7, lines 13-18) judged to correspond to one of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18).

As to claim 17, Grossman discloses a reproduction method for a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67 and column 6, lines 1-7) having both content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45) and registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18), comprising:

- a receiving step (using tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

- a first reproducing step for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

- an instruction receiving step (using remote control receiver, 48) for receiving a user instruction (column 6, lines 11-15);

- an instruction judging step (using microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18); and

a second reproducing step for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) when the received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

As to claim 19, Grossman discloses a recording apparatus (Fig. 3; ROM, 40) for recording a computer program (column 6, lines 15-18 and lines 33-38) which is used by a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67 and column 6, lines 1-7) having both content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45) and registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18), comprising:

- a receiving step (using tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

- a first reproducing step for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

- an instruction receiving step (using remote control receiver, 48) for receiving a user instruction (column 6, lines 11-15);

- an instruction judging step (using microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18); and

a second reproducing step for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) when the received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman as applied to claims 7 and 8 above, and further in view of Eyer et al. (Eyer) (6,588,015).

As to claims 9 and 12, while Grossman discloses a means to prevent the reproduction of commercial content for subscribers (column 3, lines 56-64), he fails to specifically disclose a canceling means for canceling a reproduction of the commercial content, the canceling means further including:

termination instruction receiving means for receiving a termination instruction from a user to terminate the reproduction of the commercial content being reproduced;

and acceptance judging means for judging, in accordance with a content of the user instruction judged to correspond to one of the stored user instructions, whether the termination instruction should be accepted,

wherein the canceling means cancels the reproduction of the commercial content being reproduced when the termination instruction is judged to be acceptable.

In an analogous art, Eyer discloses a digital broadcast system (Fig. 1) which provides a plurality of service levels (column 2, lines 44-60) for digital audio, video or multimedia data (column 2, lines 36-39) comprising a bypass (or canceling) means to jump to a point after a commercial (Fig. 10; column 16, lines 37-45), a means to receive the user instruction to skip the commercial (column 16, lines 41-45), and a means to determine if the skip option should be allowed for the subscriber (Fig. 10, wherein only the pay customer has access to jump to a point after the commercial; column 16, lines 51-59), wherein the skip option is available only if the user is a found to be a subscriber (column 16, lines 37-60) for the typical advantage of allowing paying customers the convenience of skipping intrusive advertisements (column 2, lines 44-60).

It would have been obvious of to one of ordinary skill in the art at the time of invention by applicant to modify Grossman's system to include canceling means for canceling a reproduction of the commercial content, the canceling means further including: termination instruction receiving means for receiving a termination instruction from a user to terminate the reproduction of the commercial content being reproduced; and acceptance judging means for judging, in accordance with a content of the user instruction judged to correspond to one of the stored user instructions, whether the termination instruction should be accepted, wherein the canceling means cancels the reproduction of the commercial content being reproduced when the termination

instruction is judged to be acceptable, as taught by Eyer, for the typical advantage of allowing paying customers the convenience of skipping intrusive advertisements.

As to claims 10 and 13, Grossman and Eyer disclose canceling the reproduction of the commercial content for a subscriber during a broadcast program when the broadcast program is a specified program (wherein the user specifies an advertisement in the current program to be skipped; see Eyer at column 16, lines 37-45).

7. Claims 11 and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman and Eyer as applied to claims 10 and 13 above, and further in view of Blahut et al. (Blahut) (5,532,735).

As to claims 11 and 14, while Grossman and Eyer disclose a subscription judging means to determine whether a user is subscribed to a broadcast service (wherein only a pay customer can advance to a point after the commercial; See Eyer at column 16, lines 51-59) and wherein the canceling means cancels the reproduction of the commercial content when the broadcast service is judged to be a subscribed broadcast service (See Eyer at column 16, lines 37-60), they fail to specifically disclose a means to judge if a broadcast program is a pay program.

In an analogous art, Blahut discloses an interactive television system (Fig. 3; column 1, lines 7-9) comprising a means to determine if a viewer has selected a VOD (or pay) program (Fig. 5; step 228) whereupon the viewer can select if they wish to cancel a set of advertisements during that program (column 5, lines 27-35) for the

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advantage of allowing a subscriber a choice in advertising and billing amounts for a specific pay program (column 1, lines 34-36 and column 2, lines 19-24).

It would have been obvious of to one of ordinary skill in the art at the time of invention by applicant to modify Grossman and Eyer's system to include means to judge if the broadcast program is a pay program, as taught by Blahut, for the advantage of allowing a subscriber a choice in advertising and billing amounts for a specific pay program.

Conclusion

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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James Sheleheda
Patent Examiner
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PRIMARY EXAMINER